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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,844	04/05/2000	Toshitsugo Ono	P00,0251	6442

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05/29/2002

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 05/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,844

Applicant(s)

ONO ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed March 08, 2002.

Claims 1-20 were amended and are pending.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 2 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. 'Wherein the terminal carboxylic groups are represented by both formula 1 and formula 2' is not supported by the specification.

Objection to specification

4. The amendment filed 3-08-2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicants amended the

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specification to define H in terms of pencil hardness within claim 5. Although Applicant amended with the intent to define the term, the amendment to page 9, line 6 through 10, is clearly new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections – 35 USC 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 5, the term, H is indefinite because it is not defined.

Claim Rejections – 35 USC § 103(a)

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9, 11, 14-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. (U.S. 5,536,425) for the reasons set forth in paragraph 5, in the previous office action, mailed November 30, 2001. Regarding the amendments

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to claims 1-20, the prior art of Kondo includes such limitation because the changes to the claims were clarification of indefinite claim language and were subsequently previously rejected based upon the prior art.

Claim Rejections – 35 USC § 103(a)

9. Claims 10, 12-13, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. (U.S. 5,536,425) in view of Akutsu (U.S. 5,864,357) for the reasons set forth in paragraph 7, in the previous office action, mailed November 30, 2001. Regarding the amendments to claims 1-20, the prior art of Kondo includes such limitation because the changes to the claims were clarification of indefinite claim language and were subsequently previously rejected based upon the prior art.

Response to Arguments

10. Applicant's amendments in regards to 35 USC 112, second paragraph have overcome the indefiniteness of 'major surfaces', 'on light transmitting layer' and 'In, Sn and Sn' by further defining the indefinite claim language. Applicant's traverse in regards to 35 USC 112, second paragraph have been considered but are unpersuasive in defining H. Although Applicant attempted to define the term, the specification was change to include information defining H that was not previously disclosed in the specification. Because this practice is improper the rejection is maintained.

Applicant's arguments of rejection under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. (U.S. 5,536,425) has been considered but is unpersuasive. Applicant argues the field of endeavor, for the claimed invention, relates to the purpose of providing a disc-shaped optical recording medium in which scratches or deposition of dust and dirt on the disc surface may be inhibited to reduce the recording and/or reproducing errors where the field of Kondo relates to the purpose of providing a coating type or metal thin film type magnetic recording medium, which constitutes intended use. Intended use is given little patentable weight. Applicant argues Kondo teaches a different medium and structure which operate under different conditions. Examiners disagrees because Kondo teaches a recording medium having a structure of $R-COO-R_1-N+R_2R_3R_4$ where R, R₂, R₃ and R₄ represents H or a hydrocarbon group having from 6 to 22 carbon atoms, under similar conditions, constituting that Kondo and the claimed invention are of the same field of endeavor. Applicant argues Kondo does not teach a recording portion formed on...the support and a light transmitting layer comprising a surface or the terminal carboxylic groups represented by both formula 1 and 2. This is not true because Kondo discloses a recording medium comprising a support including a glass substrate which constitutes a light transmitting layer that can be illuminated by light comprising inorganic materials. Additionally Kondo discloses a terminal carboxylic group represented by the formula. This argument is irrelevant because it is based on new matter material. Applicant argues Kondo does not disclose 'wherein the light transmitting layer has a thickness t of 10 to 177 μm ... wherein the light transmitting layer satisfies the specified relationship'. Although Kondo does not explicitly

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disclose the thickness or specified relationship of the light transmitting layer, the thickness of light transmitting layer has a direct effect on the luminance. Therefore it would be obvious to optimize the thickness to gain improved luminance as taught by Kondo. Applicant further argues Kondo does not address hardness of the side of an optical recording medium or surface resistance... wherein a surface tension of the light transmitting layer is set to a value that is smaller than a critical surface tension or 'wherein a moisture absorption ratio of the light transmitting surface layer is set to be higher than a moisture absorption ratio of the light transmitting layer'. The Applicant has failed to present showings that Kondo cannot show these claimed features.

Applicant's remarks to rejection under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. (U.S. 5,536,425) in view of Akutsu (U.S. 5,864,357) has been considered but is unpersuasive. Applicant argues the purpose of Akutsu is different from the purpose of the claimed invention, which is drawn to intended use. Intended use is given little patentable weight. Applicant further argues Akutsu is not in the same field of endeavor as the claimed invention. Akutsu is directed towards field of recording media, which is the same field of endeavor as Applicant's claimed invention.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.


Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

